

# INTELLECTUAL PROPERTY: COPYRIGHT, TRADE-MARKS, PATENTS (298HS)

2004/2005

**VOLUME 2: TRADE-MARKS** 

Abraham Drassinower Faculty of Law University of Toronto

These materials are solely for the classroom use of students in the Faculty of Law, University of Toronto



### INTELLECTUAL PROPERTY: COPYRIGHT, TRADE-MARKS, PATENTS (298HS)

#### 2004/2005

**VOLUME 2: TRADE-MARKS** 

Abraham Drassinower Faculty of Law University of Toronto

These materials are solely for the classroom use of students in the Faculty of Law, University of Toronto Digitized by the Internet Archive in 2018 with funding from University of Toronto

# Volume 2: Trade-marks Table of Contents

# I. Introduction

James D. Kokonis, "The Scheme of the Canadian Trade-Marks Act," in Gordon F. Henderson, ed., <i>Trade-Marks Law of Canada</i> (Scarborough: Carswell, 1993), at 75-95	
II. Passing Off	
Warnink v. J. Townend & Sons Ltd., [1979] A.C. 731 (H.L.)  Institut National des Appellations d'Origine des Vins et Eaux-de-Vie v. Andres Wines Ltd. (1990), 30 C.P.R. (3d) 279 (Ont.C.A.)  Cadbury Schweppes Ltd. v. Pub Squash Co. Ltd., [1981] 1 All E.R. 213 (P.C.)  Consumers Distributing Co. Ltd. v. Seiko Time Canada Ltd. (1984), 1 C.P.R. (3d) 1 (S.C.C.)  Reckitt & Colman Products Ltd. v. Borden Inc., [1990] 1 All E.R. 873 (H.L.)	30 32 42
A. Reputation and Evidence	
Orkin Exterminating Co. Inc. v. Pestco Co. of Canada Ltd. (1985), 50 O.R. (2d) 726 (C.A.)	
B. Common Field of Activity	
McCulloch v. Lewis A. May Ltd., [1947] 2 All E.R. 845 (Ch.)	119
(B.C.C.A.)	
III.Trade-marks	
A. Registrability and Registration	
(i) Clearly Descriptive or Misdescriptive	
Deputy Attorney-General of Canada v. Biggs Laboratories Ltd. (1964), 42 C.P.R. 129 (Ex.Ct.)	161 162 165
(ii) Functionality	

Pizza Pizza Ltd. v. Registrar of Trade Marks (1989), 26 C.P.R. (3d) 355 (F.C.A.)	
(vi) Acquired or Secondary Meaning	
Carling Breweries Ltd. v. Molson Companies Ltd. (1984), 1 C.P.R. (3d) 191 (F.C.T.D.)	190
(vii) Confusing with a Registered Mark	
Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp. (1968), 57 C.P.R. 1 (S.C.C.)	201
(viii) Persons Entitled to Registration: Use and Proposed Use	
Lin Trading Co. Ltd. v. CBM Kabushiki Kaisha (1988), 21 C.P.R. (3d) 417 (F.C.A.)	229
B. Licensing	
Breck's Sporting Goods Co. Ltd. v. Magder (1975), 17 C.P.R. (2d) 201 (S.C.C.)	238
C. Expungement	
(i) Loss of distinctiveness	
Aladdin Industries Inc. v. Canadian Thermos Products Ltd. (1969), 57 C.P.R. 230	244
(Ex.Ct.)	
(ii) Non-use	
Adams v. Societe des Produits Nestle (1996), 72 C.P.R. (3d) 100 (Trade Marks Bd.)	
D. Infringement	
(i) Confusing Usage	
Pepsi-Cola Co. of Canada Ltd. v. Coca-Cola of Canada Ltd., [1940] 1 D.L.R. 161 (S.C.C.)	
(ii) Bona Fide Use Defence	
Bagagerie SA v. Bagagerie Willy Ltee (1992), 45 C.P.R. (3d) 503 (F.C.A.)	297
(iii) Concurrent Usage	
Kayser-Roth Canada Ltd. v. Fascination Lingerie Inc. (1971), 3 C.P.R. (2d) 27 (F.C.A.)	305

# (iv) Comparative Advertising

Clairol International Corp. v. Thomas Supply & Equipment Co. Ltd. (1968), 55 C.P.R. 176 (Ex.Ct.)	311
Eye Masters Ltd. v. Ross King Holdings Ltd. (1992), 44 C.P.R. (3d) 459 (F.C.T.D.)	324
(v) Dilution	
Cie Generale des Etablissements Michelin v. C.A.WCanada (1996), 71 C.P.R. (3d) 348 (F.C.T.D.)	333
Source Perrier SA v. Fira-Less Marketing Co. Ltd. (1983) 70 C.P.R. (2d) 61 (F.C.T.D.)	

